

RECEIVED
CENTRAL FAX CENTER

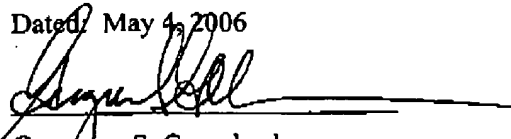
MAY 04 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Serial No. 09/836,378
First Named Inventor: Yap
Title: DVR SYSTEM
Filed: April 17, 2001
TC/AU: 2616
Examiner: Jamie J. Vent
Docket No.: PD-200144

) I hereby certify that this correspondence is
) being facsimile transmitted to the United
) States Patent & Trademark Office, Fax No.
) (571) 273-8300
) on this date: May 4, 2006
)
)
)

Dated: May 4, 2006


Georgann S. Grunebach
Registration No. 33,179

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

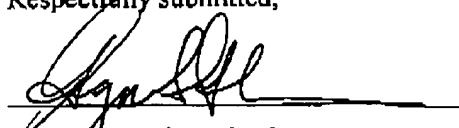
The applicants request review of the final rejection in the above-identified application.
No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.

I am the attorney or agent of record.

Respectfully submitted,


Georgann S. Grunebach
Reg. No. 33,179
Attorney for Applicants

Dated: May 4, 2006

The DIRECTV Group, Inc.
Patent Docket Administration
Bldg. R08, M.S. A109
P.O. Box 956
2230 E. Imperial Highway
El Segundo, CA 90245-0956
Phone: (310) 964-4615

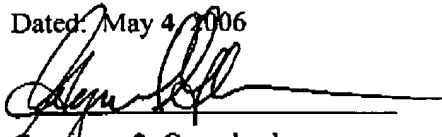
MAY 04 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Serial No. 09/836,378
First Named Inventor: Yap
Title: DVR SYSTEM
Filed: April 17, 2001
TC/AU: 2616
Examiner: Jamie J. Vent
Docket No.: PD-200144

) I hereby certify that this correspondence is
) being facsimile transmitted to the United
) States Patent & Trademark Office, Fax No.
) (571) 273-8300
) on this date: May 4, 2006
)

) Dated: May 4, 2006
)

) 
) Georgann S. Grunebach
) Registration No. 33,179
)

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REASONING ACCOMPANYING A PRE-APPEAL BRIEF REQUEST FOR REVIEW

The applicants file herewith a Notice of Appeal and respectfully request review of this case prior to filing an appeal brief. As addressed below, the rejections on the record omit essential elements required for a *prima facie* rejection. Thus, the applicants respectfully request allowance of the claims or the reopening of prosecution.

RELEVANT PROSECUTION HISTORY

A First Office action, dated September 30, 2006, rejected claims 1, 2, 4, 13, 19 and 20 as anticipated by Bellamy (U.S. Pat. No. 6,209,025) and claims 3, 5-7, 10, 11 and 15-18 as unpatentable over Bellamy in view of Browne (WO 92/22983). Claims 8, 9, 12, and 14 were also rejected as unpatentable over Bellamy in view of Vallone (US 6,642,939).

In response to the First Office action, the applicants pointed out the deficiencies of the rejections over Bellamy and the combination of Bellamy and Browne. In particular, the response indicated that the rejections failed to indicate where Bellamy describes or suggests 1) digital video recording; 2) storing selected content from the tuner; and 3) storing status parameters relating to the recording function of the video recorder. The details of the applicants arguments are provided below in the sections entitled "The Rejections Under 35 U.S.C. § 102."

A Final Office action was mailed on March 30, 2006, maintaining the rejections of the First Office action. In response to the applicants' arguments, the Final Office action attempted to justify the rejections by referring to the alleged recording capabilities of

Bellamy and stating that Bellamy describes "providing status parameters indicating functionality of said digital video recorder including one parameter relating to the recording function of the digital video recorder." (p. 3). Because the applicant and the Examiner have arrived at diametrically opposed positions, the applicant had little choice but to file this pre-appeal brief request and a notice of appeal.

REJECTIONS UNDER 35 U.S.C. § 102

Claim 1 is directed to a multi-function digital video recorder that digitally stores content received through a tuner. The recited digital video recorder includes a memory that stores selectable status parameters indicating the functionality of the digital video recorder. These parameters are derived from content provided from the tuner which is stored on the video recorder and the functions associated with the recorder including a recording function. Examples of the parameters, which are recited in various dependent claims, include the amount of record time, current delay and the hard disk capacity. The recited video recorder also includes a telephone answering device for receiving voice signals and caller ID signals representing a telephone message from a caller and converting the voice signals and caller ID signals into digital signals.

As noted briefly above, the First Office Action and the Final Office Action contend that Bellamy discloses: 1) a digital video recorder; 2) a recorder memory for storing a plurality of selectable status parameters indicating functionality of the video recorder; and 3) the status parameters including one parameter related to the recording function of the digital recorder. A brief review of the portions of Bellamy referenced by the Office actions reveals that Bellamy does not disclose any of these elements.

Bellamy Does Not Disclose A Digital Video Recorder

First, Bellamy does not disclose a digital video recorder, let alone one that stores parameters relating to operating functions of the recorder including a recording function parameter. Bellamy relates to a television set top box that allows a user to operate a television in conjunction with various computer functions such as Internet and telephone access. The enhanced set top box (ETSB) 5 in Bellamy is not a digital video recorder as recited in claim 1 and does not store content received through the tuner. In fact, contrary to the Final Office action ("storage capabilities are either present in the DRAM or the storage medium" p. 2), there is not even disclosure in Bellamy to indicate that the ETSB 5 has any storage capability other than DRAM. The storage capability of DRAM is insufficient to meet the massive storage requirements of digital video recording. Further, Bellamy does not

disclose nor suggest using the DRAM in the ETSB 5 to record digital video content received through the tuner. Thus the ETSB 5 with DRAM cannot be a digital video recorder.

The Office actions have cited Col. 4, ll. 50-64 and Col. 8, ll. 53 + to indicate that the ESTB 5 in Bellamy is a digital video recorder. Col. 4, ll. 50-64 references the storage of a pop-up window on DRAM which may be displayed on the television. This section relates to a mechanism to allocate pixels from the digital TV signal to render the pop-up window but not the ability to record the digital TV signal such as by a digital video recorder. Accordingly to Bellamy, the pop-up window displays static data such as "text, graphics, PC application windows" (Col. 3, ll. 40-41), a virtual keyboard (col. 4, ll. 12-16), caller information (Col. 6, l. 64-Col. 7, l. 1), telephone commands (Col. 7, ll. 12-17), e-mail (Col. 7, ll. 29-35), Internet information feed (Col. 7, ll. 39-46) and speed dialing (Col. 8, ll. 2-3). None of these items is dynamic as digital video is and thus storing the pop-up window in the ESTB 5 is not digital video recording.

Similarly, Col. 8, ll. 57-59 discloses using "an enhanced video cassette recorder" in place of the ETSB 5. A video cassette recorder is an analog recording device and, thus, this part of Bellamy also does not anticipate the element of a digital video recorder in claim 1.

Bellamy Does Not Disclose Storing Parameters Relating To Functions Of The Digital Video Recorder Or Recording Functions

None of the so called stored parameters in the ETSB 5 of Bellamy relate to the actual recorder as in claim 1. The Final Office action states that:

"Information such as program information, pop-up information, user information, and information regarding system are all acceptable parameters that are used to operate the system as well as to record program information. The program and parameter information can be recorded/reproduced on the recording medium for playback and recording operations." (p. 3)

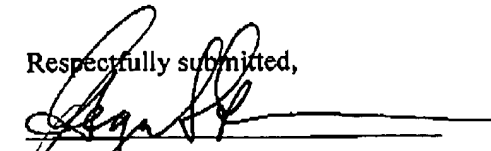
This portion of the Office action indicates a fundamental misunderstanding of Bellamy because the Office action cannot cite any specific part of Bellamy which supports the above assertion. Claim 1 recites storing information derived from the recorder functions and not, as the Final Office action seem to indicate, using information to control the recorder for playback or recording purposes. There is simply no description in Bellamy indicating that any function of the ETSB 5 is stored with the pop-up window let alone a recording function. The only information that is stored on the ESTB 5 of Bellamy is the pop-up window. The

only data input to the pop-up window is from the data link 8 and, thus, as explained above, the information stored relates to PC/telephone functions and not the so-called recorder (asserted as the ESTB 5). As noted above, Col. 4, ll. 50-64 references the storage of a pop-up window that may be displayed on the video image on the television, but the contents of the pop-up window do not relate to a digital video recorder function or parameters relating to recording operations. Further, all of the description in Bellamy relating to the content of the pop-up window indicates that any such information relates solely to the personal computer and telephone functions. This is not surprising, because there is no disclosure in Bellamy relating to any digital recording capability of the ETSTB 5 let alone display of parameters from recording operations.

It is well settled that "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051 (Fed. Cir. 1987). The Office has not provided any evidence or contention of how Bellamy discloses: 1) a digital video recorder; 2) the recorder storing status parameters indicating functionality of the digital video recorder; and 3) the parameters including at least one parameter relating to the recording function of the digital video recorder. Thus, it is respectfully submitted that no *prima facie* case of anticipation of claim 1 has been made.

Reconsideration of the application and allowance thereof are respectfully requested. If there is any matter that the examiner would like to discuss, the examiner is invited to contact the undersigned representative at the telephone number set forth below.

Respectfully submitted,



Georgann S. Grunebach
Reg. No. 33,179
Attorney for Applicants

Dated: May 4, 2006

The DIRECTV Group, Inc.
Patent Docket Administration
Bldg. R08, M.S. A109
P.O. Box 956
2230 E. Imperial Highway
El Segundo, CA 90245-0956
Phone: (310) 964-4615